REMARKS

The Office Action of April 15, 2004 has been carefully reviewed.

Claim Rejection 35 U.S.C. §103.

The rejection of claims 5, 7, and 8 under 35 U.S.C. §103(a) as being unpatentable over Wood ('007) in view of Moorman ('033) is respectfully traversed.

The disclosure of Wood '007, as cited, is not prior art under §103 because the filing date of October 17, 2002 for the disclosure cited is almost a year after the filing date of the present application. While the '007 application relies on a provisional application 60/330,298 filed before the present application, this date only applies to the disclosure of the '007 application that is in common with the provisional application 60/330,298, not to the new matter added after the filing of the present application.

The relevant disclosure of Wood in this situation is limited to the disclosure of the provisional application 60/330,298 (henceforth Wood 60/330,298). This disclosure is principally at page 1, line 20 through page 2, line 6 and describes:

"a coaxial needle biopsy technique with the outer needle coated with a non-conducting polymer that insulates the needle shaft and the tissue immediately in contact with the shaft."

Generally, it is incorrect to say that Wood 60/330,298 includes any teaching that the exposed first end of an introducer shaft forms an electrically conductive surface or that Wood 60/330,298 teaches that this surface extends continuously from one millimeter to five centimeters and is preferably two centimeters or that Wood 60/330,298 teaches that the cauterization electrode may be a monopolar electrode requiring the use of a ground pad as relied on in this Office Action. These are all disclosures in Wood '007 after the filing of the present application.

This actual description of Wood 60/330,298 is consistent with the prior art described in the present application at page 3, paragraphs 7 and 8 citing an article entitled *Electrocautery of the Track After Needle Biopsy of the Liver to Reduce Blood Loss* in which an inner biopsy needle containing the specimen, and shielded by an outer needle with a thin

coating of polyethylene, provides an electrical conduit for cauterization. As noted at paragraph 9 of the present invention, this use of the inner biopsy needle for ablation may cause thermal damage to portions of the biopsy specimen.

Because Wood '007 as cited is not prior art, the combination of Wood '007 and Moorman as stated fails.

Assuming that all the new matter added to Wood '007 were prior art, the combination of Wood and Moorman would not be suggested to one of ordinary skill in the art. Wood and Moorman deal with radically different ablation technologies, Wood with what is termed in the art as "radiofrequency ablation" in which resistive current flow in the tissue dominates and Moorman with a "microwave ablation" in which induced current flow in the tissue, possibly through an insulating dielectric, is the principle mechanism. These technologies are sufficiently different that one of ordinary skill in the art would not combine structures for them nor expect that what succeeded in microwave ablation would be successful in radiofrequency ablation. For example, a microwave ablation antenna may be electrically insulated from the tissue being ablated (see for example, Moorman's description of Fig. 3 in which the center conductor 55 is covered with an insulator 42) whereas this structure would prevent radiofrequency ablation from occurring.

Assuming, notwithstanding the foregoing, that the combination of Moorman and Wood would be suggested to one of ordinary skill in the art, this person of ordinary skill in the art would not be lead to the combination proposed by the Examiner. One of ordinary skill in the art would recognize that Moorman teaches a microwave antenna structure that is unsuitable for radiofrequency conduction, and would therefore be lead to use the biopsy needle itself for ablation as is clearly taught in the prior art.

The rejection of claim 10 as being unpatentable over Wood '007 in view of Lennox ('137) is respectfully traversed as discussed above for the reason that Wood '007 as relied upon is not prior art.

Assuming that all the new matter added to Wood '007 were prior art, Applicant believes that Lennox teaches away from the combination proposed by the Examiner by showing a thermosensor that plugs the opening of a tube and thus could serve neither as an introducer shaft nor as a biopsy needle. Even in combination with Wood, there is no teaching

in Lennox of placing a thermosensor on the introducer shaft as proposed by the present invention.

In light of these remarks and comments, it is believed that claims 5-8 and 10 are now in condition for allowance and allowance is respectfully requested.

Respectfully submitted,

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